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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,097	02/16/2006	Nabil J Abu Nassar	7044-X07-139	7186
27317 7590 01/09/2008 FLEIT KAIN GIBBONS GUTMAN BONGINI & BIANCO 21355 EAST DIXIE HIGHWAY SUITE 115 MIAMI, FL 33180			EXAMINER VON BUHR, MARIA N	
			ART UNIT 2125	PAPER NUMBER
			MAIL DATE 01/09/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/525,097	Applicant(s) ABU NASSAR ET AL.	
	Examiner M.N. Von Buhr	Art Unit 2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005 & 31 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20071231</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application is a continuation of Serial No. PCT/IL03/00679 and is, therefore, accorded the benefit of the earlier filing date of 17 August 2003. Any previously presented rejections or objections which are not expressly repeated in this Office action are hereby withdrawn.
2. Examiner acknowledges receipt of Applicant's preliminary amendment, received 17 February 2005; which amends claims 1-17 and 20, and cancels claim 21. Claims 1-20 are now pending in this application.
3. Receipt is acknowledged of papers submitted under 35 U.S.C. §119(a)-(d), which papers have been placed of record in the file.
4. Examiner acknowledges receipt of Applicant's information disclosure statement, received 31 December 2007, with accompanying reference copy. This submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, it has been taken into consideration for this Office action.
5. Examiner acknowledges receipt of Applicant's formal drawings. These drawings are acceptable.
6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "stereotactic frame" and "robot's arm" (claim 2); "activating means are electrical, hydraulic or manual" (claim 14); "conveyor" (claim 16); "ball joint" and "hinge" (claim 18); and "probes" and "needles" (claim 20) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
7. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by Examiner, Applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

8. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
9. The specification is objected to, because Fig. 4a is not described anywhere in the description.
10. The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1-20 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In this regard, the specification seems to be presented more like a design patent application, instead of a utility patent application, since the only detailed description of the instant invention seems to be a merely superficial explanation of the drawings. There is no actual, detailed disclosure concerning the instantly claimed "any configuration of electrode positioning may be attained," mounting of elements "directly or indirectly," moving/adjusting of various holders, "actuators/activating means" nor such being "electrical, hydraulic or manual."

12. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which Applicant regards as his invention.

13. Claims 1-20 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The following claimed elements lack clear and proper antecedent basis: "the head" (claim 1), "the electrode" (claims 7 and 19), "the electrode guiding tube" (claim 8), "each terminal" (claims 9, 11, 12 and 18), "each tube" (claim 10), "the terminals" (claim 13), "the activating means" (claim 14), "the movable elements" (claim 16), and "the terminal holder" (claim 18).

In addition, as per claim 1, the claim appears to be incomplete, because there is no clear structural relationship between the "electrodes" and any other physical elements (i.e.; base, terminal holders, extended

guides, or electrode holders) of the claimed system. Furthermore, the term “suitable” is deemed to be a term of degree, which has not been defined in such a manner as to be clear and definite.

As per claim 6, the claim appears to be incomplete, because there is no clear structural relationship between the “chamber” and any other physical elements (i.e.; base, terminal holders, extended guides, or electrode holders) of the claimed system.

As per claim 19, the claim appears to be incomplete, because there is no clear structural relationship between the “electrode” and/or “tube” and any other physical elements (i.e.; base, terminal holders, extended guides, or electrode holders) of the claimed system.

The remainder of the claims are rejected as necessarily incorporating the above-noted ambiguities of their parent claims.

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by Applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by Applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by Applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-20 are rejected under 35 U.S.C. §102(e), as being clearly anticipated by Arambula et al. (U.S. Patent No. 7,166,113, with an effective filing date of 22 June 2000; newly cited).

As best understood by Examiner, in view of the numerous ambiguities addressed above, Arambula et al. are deemed to anticipate the instant claims by teaching a “surgical instrument positioning system, comprising: at least one support; a cross member having at least one curved end portion, the at least one curved end portion being held by the at least one support such that the cross member is rotatable about an axis extending through a center of curvature of the at least one curved end portion of the cross member; and at least one surgical instrument holder suspended from the cross member” (the abstract). Applicant’s attention is directed to Figs. 1-6 and 16A-B.

16. Claims 1-20 are rejected under 35 U.S.C. §102(b), as being clearly anticipated by Day et al. (U.S. Patent No. 5,891,157; newly cited).

As best understood by Examiner, in view of the numerous ambiguities addressed above, Day et al. are deemed to anticipate the instant claims by teaching a “noninvasive apparatus for supporting tools associated with a stereotactic apparatus and procedures to guide tools along any selected path. In one embodiment of the invention, the tool support system is mounted to a skull clamp holding a patient's head. In another embodiment, the tool holder and an articulated arm and probe are mounted to the tool support system which in turn, is mounted to the side rails of a table supporting a patient” (the abstract). Applicant's attention is directed to Figs. 1, 3 and 5.

17. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. Applicant is advised to carefully review the cited art, as evidence of the state of the art, in preparation for responding to this Office action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M.N. Von Buhr whose telephone number is 571-272-3755. The examiner can normally be reached on M-F (9am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Rodriguez can be reached on 571-272-3753. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



M.N. Von Buhr
Primary Patent Examiner
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